REMARKS

Claims 1-13 and 15-33 are pending herein. By the Office Action, claims 18-33 are withdrawn from consideration as being drawn to a non-elected invention; claims 1, 2, 4-11 and 15-17 are rejected under 35 U.S.C. §102; and claims 3 and 12-14 are rejected under 35 U.S.C. §103. By this amendment, claim 1 is amended and claim 14 is canceled.

The attached Appendix includes marked-up copies of each rewritten claim (37 C.F.R. §1.121(c)(1)(ii)).

I. Restriction/Election

Applicant affirms the election of Group I, claims 1-17, with traverse. The Office Action indicates that claims 18-33 are withdrawn from consideration. Applicant respectfully requests withdrawal of the Restriction Requirement.

The Restriction Requirement is traversed because the claims of Groups I and II are drawn to sufficiently inter-related inventions to warrant examination thereof in a single application. Group I is drawn to a method for manufacturing ceramics and Group II is drawn to an apparatus for practicing the method of manufacturing ceramics of Group I. Thus, a search for the invention of Group I necessarily encompasses the search for apparatus of Group II. Although the classifications may be different, the subject matter is sufficiently overlapping that concurrent search of all of the claims does not create a serious burden. Applicant respectfully requests reconsideration and withdrawal of the Restriction Requirement.

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent claims. MPEP §803. Applicant respectfully submits that there would be no serious burden on the Patent Office to examine all of the present claims because the subject matter of Groups I and II is sufficiently related that a search of any one group would encompass the search of the subject matter of the remaining groups.

Thus, Applicant respectfully submits that the Restriction Requirement should be withdrawn.

II. Rejections under §102

A. Satoh et al., U.S. Patent No. 6,232,167

Claims 1, 2, 5, and 15-17 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by Satoh et al. Applicants respectfully traverse this rejection.

Although Applicant does not necessarily agree with this rejection, by this Amendment, claim 1 is amended to incorporate the subject matter of non-rejected claim 14. The rejection is thus moot.

In view of the amendment of claim 1, Applicant respectfully submits that Satoh does not anticipate claims 1, 2, 5, and 15-17. Reconsideration and withdrawal of the rejection is respectfully requested.

B. Tatsumi, U.S. Patent No. 6,606,391

Claims 1, 4, and 6-11 are rejected under 35 U.S.C. §102(e) as allegedly anticipated by Tatsumi. Applicant respectfully traverses this rejection.

Although Applicant does not necessarily agree with this rejection, by this Amendment, claim 1 is amended to incorporate the subject matter of non-rejected claim 14. The rejection is thus moot.

In view of the amendment of claim 1, Applicant respectfully submits that Tatsumi does not anticipate claims 1, 4 and 6-11. Reconsideration and withdrawal of the rejection are respectfully requested.

III. Rejections under §103

A. Satoh et al. in view of Chivukula et al., U.S. Patent No. 6,146,905

Claim 3 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Satoh in view of Chivukula. Applicant respectfully traverses this rejection.

Although Applicant does not necessarily agree with this rejection, by this Amendment, claim 1 is amended to incorporate the subject matter of non-rejected claim 14. The rejection is thus moot.

For at least these reasons, claim 3 would not have been obvious over the cited references. Reconsideration and withdrawal of the rejection are respectfully requested.

B. Satoh et al. in view of Leung et al., U.S. Patent No. 5,563,762

Claim 12 is rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Satoh. in view of Leung. Applicants respectfully traverse this rejection.

Although Applicant does not necessarily agree with this rejection, by this Amendment, claim 1 is amended to incorporate the subject matter of non-rejected claim 14. The rejection is thus moot.

For at least these reasons, claim 3 would not have been obvious over the cited references. Reconsideration and withdrawal of the rejection are respectfully requested.

C. Satoh et al. in view of Leung et al. further in view of Hsu et al., U.S. Patent No. 5,932,904 and further in view of Araki et al., U.S. Patent No. 6,207,236

Claim 13 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Satoh in view of Leung further in view of Hsu and further in view of Araki. Applicants respectfully traverse this rejection.

Although Applicant does not necessarily agree with this rejection, by this Amendment, claim 1 is amended to incorporate the subject matter of non-rejected claim 14. The rejection is thus moot.

For at least these reasons, claim 13 would not have been obvious over the cited references. Reconsideration and withdrawal of the rejection are respectfully requested.

D. Satoh et al. in view of McMillan et al., U.S. Patent No. 5,456,945

Claim 14 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Satoh in view of McMillan. Applicant respectfully traverses this rejection as it may be deemed to apply to claim 1, which has been amended to incorporate original claim 14.

The Office Action cites Satoh for teaching a method of depositing a ceramic material on a substrate that comprises heating and vaporizing bismuth raw material and mixing it with argon and oxygen. However the Office Action admits that Satoh fails to teach or suggest a misted chemical vapor deposition or LSMCD process. To cure this deficiency in the teachings of Satoh, the Office Action cites McMillan.

However, McMillan fails to teach or suggest mixing the raw material species with an active species and feeding the mixture to the substrate to form the ceramic film. Mixing the raw material species with the active species imparts kinetic energy to the raw material species before forming a ceramic film. Neither Satoh nor McMillan address this in the methods they describe. Thus, McMillan fails to cure the deficiencies in the teachings of Satoh. Applicant submits that one of ordinary skill in the art would not have been able to derive the claimed invention based on the teachings of Satoh and McMillan.

For at least these reasons, claim 14 would not have been obvious over the cited references. Reconsideration and withdrawal of the rejection are respectfully requested.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicant submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-33 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Stephen Tu
Registration No. 52,304

JAO/SXT:amw

Attachment:
Appendix

Date: October 9, 2002

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

DEPOSIT ACCOUNT USE AUTHORIZATION
Please grant any extension necessary for entry;
Charge any fee due to our Deposit Account No. 15-0461

APPENDIX

Changes to Claims:

Claim 14 is canceled.

The following is a marked-up version of the amended claim:

1. (Amended) A method for manufacturing ceramics comprising a step of forming a ceramic film on a substrate by mixing a fine particle of a raw material species which becomes at least part of raw materials for ceramics with an active species, and feeding the mixed fine particle and active species to the substrate, wherein the ceramic film is formed by an LSMCD process or a misted CVD process.